

### **REMARKS**

In response to the final Office Action mailed in the parent application, applicant makes the following remarks. Claims 1-6, 8-10, 12-15, 18-23, 31-36, 38-46, and 75-93 are now pending in this application.

Applicant does not admit that the art cited in the Office Action is prior art and reserves to “swear behind” this cited art as provided for under 37 C.F.R. 1.131.

Applicant requests reconsideration of the prior rejections in view of 35 USC § 102(e) as amended in the AIPA. Applicant specifically requests that the examiner reconsider Juengling et al. (U.S. Patent No. 5,333,556) and Farrar (U.S. Patent No. 5,994,777) as references against the pending claims.

#### **§102 Rejection of the Claims**

Claims 1, 4, 5, 6, 8-10, 12, 14, 18, 20-23, 31, and 33-35 were rejected under 35 USC § 102(e) as being anticipated by Juengling et al. (U.S. Patent No. 5,333,556).

With regard to claim 31, among the differences, claim 31 recites “a post structure mounted on the electronic chip and capable of protecting an air-bridge structure and supporting a C4 structure.” (emphasis added). The Office Action indicated that the rejection in the prior Office Action mailed on June 14, 2002 is maintained because of the reasons therein. Further, the Office Action indicated

In addition, it is respectfully submitted that the chips of the applied prior art are capable of being used as C4 chips; therefore, it is inherent that the relevant prior art chip structures and connections are intermediate product C4 structures and connections. (emphasis added). See Office Action at page 9.

Applicant respectfully traverses that this feature is inherent in the cited art. Under MPEP 2112,

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of

conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). (emphasis added) See MPEP 2112.

Moreover, under MPEP 2112,

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added) See MPEP 2112.

Applicant respectfully submits that an assertion that a reference is "capable" of being used in a C4 structure (as cited in the current Office Action) is insufficient to establish inherency of that characteristic. Moreover, Applicant respectfully submits that this assertion that the cited art is "capable of being used as C4 chips" is conclusory and lacking "a basis in fact and/or technical reasoning" as required by MPEP 2112. Accordingly, because the cited references do not disclose the limitations of claim 31, Applicant respectfully submits that the rejection of claim 31 has been overcome and that claim 31 is in condition for allowance.

Claims 38-42 and 44-46 were rejected under 35 USC § 102(e) as being anticipated by Clevenger et al. (U.S. Patent No. 6,255,712).

With regard to claim 38, among the differences, claim 38 recites "a C4 connection coupled to the electronic chip through the plurality of conductive segments." (emphasis added). The Office Action indicated that the rejection in the prior Office Action mailed on June 14, 2002 is maintained because of the reasons therein. Further, the Office Action indicated

In addition, it is respectfully submitted that the chips of the applied prior art are capable of being used as C4 chips; therefore, it is inherent that the relevant prior art chip structures and connections are intermediate product C4 structures and connections. (emphasis added). See Office Action at page 9.

Applicant respectfully traverses this limitation is inherent in the cited art. Under MPEP 2112,

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). (emphasis added) See MPEP 2112.

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Applicant respectfully submits that an assertion that a reference is "capable" of being used in a C4 structure (as cited in the current Office Action) is insufficient to establish inherency of that characteristic. Moreover, Applicant respectfully submits that this assertion that the cited art is "capable of being used as C4 chips" is conclusory and lacking "a basis in fact and/or technical reasoning" as required by MPEP 2112. Accordingly, because the cited references do not disclose the limitations of claim 38, Applicant respectfully submits that the rejection of claim 38 has been overcome and that claim 38 is in condition for allowance.

With regard to claim 44, in addition to the remarks set forth above regarding claim 38, Applicant respectfully submits the following remarks. Among the differences, claim 44 recites "further comprising a heat sink coupled to the electronic chip." The Office Action indicated that this limitation is disclosed at column 4, line, line 29 to column 6, line 39 of Clevenger. Applicant respectfully traverses the assertion that a heat sink coupled to the electronic chip is disclosed in these citations of Clevenger and respectfully requests a citation therein disclosing this limitation. Hence, Clevenger fails to teach each of the elements of claim 44. Thus, the Office Action fails to state a *prima facie* case of anticipation with respect to claim 44.

Additionally, because claims 39-42 and 45-46 depend from and further define claim 38, Applicant respectfully submits that the rejections of claims 39-42 and 45-46 have been overcome and that claims 39-42 and 45-46 are in condition for allowance.

**§103 Rejection of the Claims**

Claims 2 and 3 were rejected under 35 USC § 103(a) as being unpatentable over the combination of Juengling et al. and Farrar (U.S. Patent No. 5,994,777). Applicant respectfully traverses this rejection. Because claims 2-3 depend from and further define claim 1, Applicant respectfully submits that the rejections of claims 2-3 have been overcome and that claims 2-3 are in condition for allowance.

Claim 19 was rejected under 35 USC § 103(a) as being unpatentable over the combination of Clevenger et al. and Farrar. Applicant respectfully traverses this rejection. Because claim 19 depends from and further defines claim 18, Applicant respectfully submits that the rejection of claim 19 have been overcome and that claim 19 is in condition for allowance.

Claim 43 was rejected under 35 USC § 103(a) as being unpatentable over Clevenger et al. Applicant respectfully traverses this rejection. Because claim 43 depends from and further defines claim 38, Applicant respectfully submits that the rejection of claim 43 have been overcome and that claim 43 is in condition for allowance.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Gregg A. Peacock, at (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

PAUL A. FARRAR

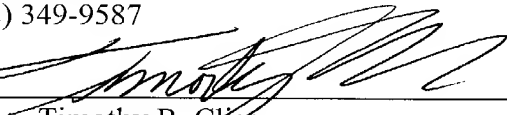
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10 April 2003

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Date of Deposit: April 10, 2003

This paper or fee is being deposited on the date indicated above with the United States Postal Service pursuant to 37 CFR 1.10, and is addressed to Box CPA, Commissioner for Patents, Washington, D. C. 20231.